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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,123	05/23/2000	Kia Silverbrook	NPA006US	9158

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AUSTRALIA

EXAMINER

RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/575,123		SILVERBROOK ET AL.	
	Examiner		Art Unit	
	Laurie Ries		2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 11-25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/30/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed 30 September 2005, to the original application, filed 23 May 2000.
2. Claims 9-10 and 26 have been cancelled. Claims 1-8, 11-25, and 27-29 are pending. Claims 1 and 15 are independent claims.
3. Claims 15 and 24-25 remain rejected under 35 U.S.C. 102(a) as being anticipated by Dymetman ("Intelligent Paper", Xerox Research Centre Europe).
4. The rejection of claims 1 and 11 under 35 U.S.C. 102(a) as being anticipated by Dymetman ("Intelligent Paper", Xerox Research Centre Europe) has been withdrawn as necessitated by amendment, however, a new grounds of rejection has been added under 35 U.S.C. 103(a).
5. Claim 2 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Walker (U.S. Patent 5,995,976).

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6. Claims 3-4, 16-19, and 21-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Greening (U.S. Publication 2001/0013009 A1).
7. Claims 5-7, 12, 20, and 27-28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Nozue (U.S. Patent 5,845,262).
8. Claim 13 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Franklin ("A Framework for Scalable Dissemination-Based Systems", ACM SIGPLAN Notices).
9. Claims 14 and 29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Wiedemer (U.S. Patent 5,860,781).
10. Claims 8 and 23 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Smith (U.S. Patent 5,181,162).

Response to Arguments

11. Applicant's arguments filed 30 September 2005 have been fully considered but they are not persuasive. It is noted that Applicant asserts on Page 7 of the Instant Amendment that the art of record, namely Dymetman, is not enabling and does not provide any teaching as to the limitations of the claimed invention; however, since Applicant does not address any one specific limitation, it is not possible for the Office to elucidate a response directed to the limitations of the claimed invention. The Office notes that the rejection of the claims as listed below cites the portions of the Dymetman disclosure that provide the teachings of the features of each claimed limitation. The Office considers the Dymetman reference, published March/April 1998, to be enabled unless Applicant can prove otherwise.

Claim Objections

12. Claim 11 is objected to because of the following informalities: Claim 11 is listed as being dependent upon claim 10 which has been cancelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

13. Claims 15 and 24-25 are rejected under 35 U.S.C. 102(a) as being anticipated by Dymetman ("Intelligent Paper", Xerox Research Centre Europe).

As per claim 15, Dymetman discloses a system for delivering an interactive printed periodical to a user on demand including a computer system that is used to produce and update intelligent paper documents (See Dymetman, Page 393, Figure 1). Dymetman also discloses allocating and recording a unique document identifier, called a doc-id (See Dymetman, Page 403, first full paragraph, lines 3-5). Dymetman also discloses associating this doc-id with a document, such as a periodical, in the system (See Dymetman, Page 403, third full paragraph, lines 1-3). Dymetman also discloses printing the document onto a substrate, such as intelligent paper sheets, using a printer networked with the computer system so as to produce printed materials, such as daily papers, meeting agendas, or hotel reservations (See Dymetman, Page 400, "Daily Papers", "Meeting agenda", and "Hotel reservations"). Dymetman also discloses that the periodical includes a number of location-indicating tags that function in cooperation with user interactive elements of the periodical, enabling a user to indicated a request for further information relating to contents of the periodical by interacting with the

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elements using a sensing device which is adapted to transmit data indicating the request to the computer system (See Dymetman, Pages 396-397, Section 3 – Technology).

As per claim 25, Dymetman discloses the limitations of claim 15 as described above. Dymetman also discloses printing the newspaper or magazine demand (See Dymetman, Page 400, paragraph 4 – “Daily Papers”). Dymetman also discloses printing the formatted information on paper and also printing the coded data (See Dymetman, Page 399, paragraphs 2-4 – “Visible and Invisible Inks”).

As per claim 24, Dymetman discloses the limitations of claim 15 as described above. Dymetman also discloses that the sensing device includes a marking nib (See Dymetman, Page 401, Section 5, paragraph 2 – “Writer-Pointer”).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman (“Intelligent Paper”, Xerox Research Centre Europe).

As per claim 1, Dymetman discloses a method of delivering an interactive printed periodical to a user on demand including a computer system that is used to

produce and update intelligent paper documents (See Dymetman, Page 393, Figure 1). Dymetman also discloses allocating and recording a unique document identifier, called a doc-id (See Dymetman, Page 403, first full paragraph, lines 3-5). Dymetman also discloses associating this doc-id with a document, such as a periodical, in the system (See Dymetman, Page 403, third full paragraph, lines 1-3). Dymetman also discloses printing the document onto a substrate, such as intelligent paper sheets, using a printer networked with the computer system so as to produce printed materials, such as daily papers, meeting agendas, or hotel reservations (See Dymetman, Page 400, "Daily Papers", "Meeting agenda", and "Hotel reservations"). Dymetman also discloses that the periodical includes a number of location-indicating tags that function in cooperation with user interactive elements of the periodical, enabling a user to indicate a request for further information relating to contents of the periodical by interacting with the elements using a sensing device which is adapted to transmit data indicating the request to the computer system (See Dymetman, Pages 396-397, Section 3 – Technology). Dymetman also discloses that the printed periodical includes the interactive information supplied by the user, including enabling a user to point to a name to find all its mentions in recent issues or to display a biography, navigating to related recent articles (See Dymetman, Page 400, third full paragraph, "Daily Papers"). While Dymetman does not disclose expressly that the printed periodical is available on demand, it is well known in the art that periodicals, such as newspapers or travel magazines, are provided to a person who either purchases an issue of said newspaper or periodical or purchases a subscription to request delivery of a particular number of

issues of said newspaper or periodical. At the time of the invention it would have been obvious to one of ordinary skill in the art to conclude that the newspapers or periodicals of Dymetman are provided to a user on demand. The motivation for this conclusion would be to provide access to a user of instant information updates such as those printed in newspapers or periodicals (See Dymetman, Page 400, third full paragraph, "Daily Papers").

As per claim 11, Dymetman discloses the limitations of claim 1 as described above. Dymetman also discloses printing the coded data to be substantially invisible in the visible spectrum (See Dymetman, Page 399, paragraphs 2-4 – "Visible and Invisible Inks").

15. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Walker (U.S. Patent 5,995,976).

As per claim 2, Dymetman discloses the limitations of claim 1 as described above. Dymetman does not disclose expressly that the further information includes editorial content. Walker discloses including editorial information in relation to publishing newspapers or magazines electronically (See Walker, Column 1, lines 14-18, and Column 2, lines 12-15). Dymetman and Walker are analogous art because they are from the same field of endeavor of distributing data electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the

editorial content of Walker with the newspaper or magazine delivery method of Dymetman. The motivation for doing so would have been to allow "surplus" information to be distributed to users thereby increasing profitability for the publisher (See Walker, Column 2, lines 24-39). Therefore, it would have been obvious to combine Walker with Dymetman for the benefit of allowing surplus information to be distributed to users thereby increasing profitability for the publisher to obtain the invention as specified in claim 2.

16. Claims 3-4, 16-19, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Greening (U.S. Publication 2001/0013009 A1).

As per claims 3-4, 16, 18, and 19, Dymetman discloses the limitations of claims 1 and 15 as described above. Dymetman does not disclose expressly that the further information relates to advertising material, which is included in the formatted information on the basis of demographics of the user. Greening discloses the inclusion of advertising materials based on a demographic profile of a user. (See Greening, Page 1, paragraph 0015). Dymetman and Greening are analogous art because they are from the same field of endeavor of presenting information to users over a computer network. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the advertising information based on user demographics of Greening with the further information of Dymetman. The motivation for doing so would have been to create a personalized experience for the user. (See Greening, Page 1, paragraph

0014). Therefore, it would have been obvious to combine Greening with Dymetman for the benefit of providing a personalized experience for the user to obtain the invention as specified in claims 3-4, 16, 18, and 19.

As per claim 17, Dymetman discloses the limitations of claim 15 as described above. Dymetman does not disclose expressly that the further information relates to advertising material, which is included with reference to user preferences. Greening discloses the inclusion of advertising materials based on user preferences. (See Greening, Page 1, paragraph 0015). Dymetman and Greening are analogous art because they are from the same field of endeavor of presenting information to users over a computer network. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the advertising information based on user preferences of Greening with the further information of Dymetman. The motivation for doing so would have been to create a personalized experience for the user. (See Greening, Page 1, paragraph 0014). Therefore, it would have been obvious to combine Greening with Dymetman for the benefit of providing a personalized experience for the user to obtain the invention as specified in claim 17.

As per claim 21, Dymetman and Greening disclose the limitations of claim 19 as described above. Dymetman also discloses receiving movement data as to the position of the mouse or sensing device relative to the newspaper or magazine (See Dymetman, Page 397, paragraphs 2-3).

As per claim 22, Dymetman and Greening disclose the limitations of claim 21 as described above. Dymetman also discloses sensing the movement of the mouse or sensing device using code (See Dymetman, Page 398, paragraphs 3-4).

17. Claims 5-7, 12, 20, and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Nozue (U.S. Patent 5,845,262).

As per claims 5 and 20, Dymetman discloses the limitations of claims 1 and 15 as described above. Dymetman also discloses including coded data with interactive elements (See Dymetman, Page 397, paragraph 1), where the data includes receiving, in the computer system, indicating data from the sensing device and of a position of the sensing device relative to the newspaper or magazine in order determine when the sensing device is used to interact with the element (See Dymetman, Page 398, paragraph 5). Dymetman does not disclose expressly including the identity of the newspaper or magazine. Nozue discloses the inclusion of information identifying the newspaper or magazine. (See Nozue, Claim 12) Dymetman and Nozue are analogous art because they are from the same field of endeavor of providing data electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the transmittal of identity data of Nozue with the system and method of Dymetman. The motivation for doing so would have been to classify the information by location or district. (See Nozue, Column 31, lines 41-60). Therefore, it would have

been obvious to combine Nozue with Dymetman for the benefit of classifying the data to obtain the invention as specified in claims 5 and 20.

As per claim 6, Dymetman and Nozue disclose the limitations of claim 5 as described above. Dymetman also discloses receiving movement data as to the position of the mouse or sensing device relative to the newspaper or magazine (See Dymetman, page 397, paragraphs 2-3).

As per claim 7, Dymetman and Nozue disclose the limitations of claim 6 as described above. Dymetman also discloses sensing the movement of the mouse or sensing device using code (See Dymetman, Page 398, paragraphs 3-4) and identifying the response from the movement being at least partially within a certain zone associated with the interactive elements (See Dymetman, page 397, paragraphs 2-3).

As per claim 12, Dymetman and Nozue disclose the limitations of claim 6 as described above. Dymetman also discloses retaining a retrievable record of the printed newspaper or magazine, being retrievable using the identification code in the coded data (See Dymetman, Page 397, paragraph 6).

As per claim 27, Dymetman and Nozue disclose the limitations of claim 20 as described above. Dymetman also discloses printing the coded data to be substantially invisible in the visible spectrum (See Dymetman, page 399, paragraphs 2-4 – “Visible and Invisible Inks”).

As per claim 28, Dymetman and Nozue disclose the limitations of claim 20 as described above. Dymetman also discloses that the periodicals or documents are retrievable by a doc-id (See Dymetman, Page 403, first full paragraph, lines 3-5).

Nozue also discloses a database for keeping a retrievable record of each periodical generated (See Nozue, Column 12, lines 13-20). Dymetman and Nozue are analogous art because they are from the same field of endeavor of providing data electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the database of Nozue with the documents of Dymetman. The motivation for doing so would have been to maintain data for later distribution (See Nozue, Column 2, lines 5-15). Therefore it would have been obvious to combine Nozue with Dymetman for the benefit of maintaining data for later distribution to obtain the invention as specified in claim 28.

18. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Franklin ("A Framework for Scalable Dissemination-Based Systems", ACM SIGPLAN Notices).

As per claim 13, Dymetman discloses the limitations of claim 1 as described above. Dymetman does not disclose expressly including distributing a number of newspapers or magazines using a mixture of multicast and pointcast communications protocols. Franklin discloses using a combination of delivery mechanisms, including both pointcast and multicast. (See Franklin, Page 97, column 1, paragraph 5). Dymetman and Franklin are analogous art because they are from the same field of endeavor of delivering information electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the combination of delivery mechanisms of Franklin with the system and method of Dymetman. The

motivation for doing so would have been to control the costs of initiating the transfer of data. (See Franklin, Page 5, column 2, paragraph 2) Therefore, it would have been obvious to combine Franklin with Dymetman for the benefit of controlling data transfer costs to obtain the invention as specified in claim 13.

19. Claims 14 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Wiedemer (U.S. Patent 5,860,781).

As per claims 14 and 29, Dymetman discloses the limitations of claims 1 and 15 as described above. Dymetman does not disclose expressly that the newspaper or magazine is printed on multiple pages and that the method includes binding the pages. Wiedemer discloses a binding or stitching device used to bind the pages of a document. (See Wiedemer, Column 4, lines 51-57). Dymetman and Wiedemer are analogous art because they are from the same field of endeavor of presenting information. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the binding of pages of Wiedemer with the system and method of Dymetman. The motivation for doing so would have been to produce a document simply and cost-effectively. (See Wiedemer, Column 1, lines 54-56). Therefore, it would have been obvious to combine Wiedemer with Dymetman for the benefit of producing a document simply and with reasonable cost to obtain the invention as specified in claims 14 and 29.

20. Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman ("Intelligent Paper", Xerox Research Centre Europe) in view of Smith (U.S. Patent 5,181,162).

As per claims 8 and 23, Dymetman discloses the limitations of claims 1 and 15 as described above. Dymetman also discloses monitoring the sensing device (See Dymetman, page 401, Section 5, bullet item 2). Dymetman does not disclose expressly including an identification code for a specific user. Smith discloses including an identification code for a user. (See Smith, Column 5, lines 3-7). Dymetman and Smith are analogous art because they are from the same field of endeavor of presenting information electronically. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the user identification code of Smith with the system and method of Dymetman. The motivation for doing so would have been to restrict user access to an object. (See Smith, Column 5, lines 1-3). Therefore, it would have been obvious to combine Smith with Dymetman for the benefit of restricting user access to obtain the invention as specified in claims 8 and 23.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is (571) 272-4095. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LR

William S. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
12/17/2005